



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,640	01/10/2002	Carlo Brugnara	13691-002005 / 470-104US2	7466

7590

10/07/2003

Gregory P. Einhorn
Fish & Richardson P.C.
Suite 500
4350 La Jolla Village Drive
San Diego, CA 92122

EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 10/07/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/043,640

Applicant(s)
Brugnara et al.

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 9, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-32 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

This office action is in response to the amendment filed on July 9, 2003.

Claims 17-32 are pending in this application.

The rejections of the previous office action are rendered moot in view of the cancellation of claims 1-16.

The following rejections are necessitated by the amendment:

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims, the definitions of the variables include the terms “(C₁-C₆) alkenyl” and “(C₁-C₆) alkynyl” groups (**all occurrences through all claims**, see e.g., definition of Y, R and R') wherein it is not clear what is intended by a 'C₁ alkenyl or alkynyl' group. An 'alkenyl' or 'alkynyl' is a group having a carbon to carbon double or triple bond and in the instant case, it is **not clear** what is an alkenyl or alkynyl group having one carbon atom. The specification provides ethenyl, etc. as examples **which groups have at least two carbon atoms**.

This rejection was made in the previous office action, applicant however, neither amended the claims nor responded to the above indicated discrepancy.

Art Unit: 1624

Claim Rejections - 35 U.S.C. § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Starnes, Chem. Abstract 69:43555. The instantly claimed compounds and the corresponding composition read on the reference disclosed compound, see the compound having RN 16778-13-5 in the enclosed copy of CAPLUS computer search report.

Applicant relies on the proviso statement “when --- is single bond, R₁ and R₂ together are =O, Y is absent, R₃ is -C(O)OEt, R₄ is H, m = 0, n = 1, R₅ is absent, then R₆ is not -OH at the para position” in the claim to overcome the rejection. This rejection does not exclude the compound disclosed in Starnes reference. The claim also contains another proviso “when --- is single bond, and R₁, R₂, R₃ and R₄ are H, Y is absent, then (a) at least one of R₅, R₆ or R₇ are other than H” (see page 4, lines 16-17). This statement is also insufficient to overcome the rejection because when the subscripts _m and _n are 0 in the claim, R₅, R₆ and R₇ are not present in the structural formula and therefore, the claim reads on the reference disclosed compound.

2. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Barili et al., Chem. Abstract 107:58774. The instantly claimed compound reads on the reference compound RN 104563-21-5, see the enclosed copy of the computer search report.

Art Unit: 1624

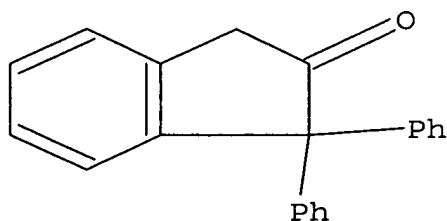
Applicant argues that the claims recite the limitation that “when --- is single bond, R₁ and R₂ taken together are =O, Y is absent, R₃ is Me, R₄ is H, m = 0, n = 1, then both R₅ and R₆ are not -OH at the para position”, which excludes the reference disclosed compound. However, such limitation is not present in claim 17. The claim contains the following proviso: “when --- is single bond, and R₁ and R₂ taken together are =O, Y is CH₂, R₃ and R₄ are H, and m = 0 and n = 1, then R₅ and R₆ are not both -OH(para)” (see page 4, lines 19-21). This statement is insufficient to overcome the rejection because the claim includes the reference disclosed compound when Y is absent and R₄ is methyl.

3. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Rosnati et al., Chem. Abstract 110:153506. The instant claims read on reference disclosed compounds, see compounds with RN 54193-73-6, etc.

Applicant relies on the proviso statements in the claim to overcome the rejection, however, the proviso statements do not exclude the reference disclosed compounds. For example, the reference disclosed compound:

RN 54193-73-6 CAPLUS

CN 2H-Inden-2-one, 1,3-dihydro-1,1-diphenyl- (9CI) (CA INDEX NAME)



Art Unit: 1624

is a tautomeric equivalent of the instantly claimed compound of formula (I) wherein:

X is C;

--- is a double bond;

R₁ and R₂ are H;

R₃ is absent;

R₄ is OR' wherein R' is H; and

m and n are 0.

There was no proviso statement to exclude any of the reference disclosed compounds.

4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Koelsch et al., Chem. Abstract 55:48596. The instant claim reads on reference disclosed compounds 102242-25-1, etc.

Applicant relies on the proviso statement "when --- is single bond, R₁ and R₂ together are =O, Y is absent, R₃ and R₄ are H, m = 0, n is 1; then (a) if R₅ is absent, R₆ is not OMe (para) or OH (para)" to overcome the rejection. The proviso in the claim excludes the compounds when R₅ is H and R₆ is OH or OMe. However, the claim includes the compounds wherein R₆ is H and R₅ is OH or OMe and since both phenyl rings substituted with R₅ and R₆ are attached to the same ring carbon, the claim continues to read on reference compounds.

Art Unit: 1624

5. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Manning et al., Chem. Abstract 94:102358. The instant claim reads on the reference compounds RN 18636-52-7, etc.

Applicant relies on the proviso statement "when --- is double bond, Y, R₂ and R₃ are absent, R₁ and R₄ are H, m = 0, (a) then n is not 0; (b) if n is 1, R₅ is absent, then R₆ is not -OMe (para), or -Br (para) or -CN (para)". The limitation (a) requires 'n to be one', however, R₅ and R₆ can be H and therefore, the claim continues to read on the reference disclosed compound. The above limitation (b) is insufficient because it excludes the compounds when R₅ is H and R₆ is Br or CN or OMe. However, the claim includes the compounds wherein R₆ is H and R₅ is Br or CN or OMe and since both phenyl rings substituted with R₅ and R₆ are attached to the same ring carbon, the claim continues to read on reference compounds.

6. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al., Chem. Abstract 74:75859. The instantly claimed compounds read on the reference disclosed compound, see the compound RN 31366-71-9 in the enclosed copy of the CAPLUS computer search report. The reference teaches the presence of the compound in a solvent and therefore, inherently teaches a composition thereof. The proviso statement in claim 1 has been fully considered but not deemed to be sufficient to overcome the rejection because - the proviso recites 'when X is C and R₁ is -OH, at least one of R₅, R₆ and R₇ is other than -H,....', however, when the subscripts _m and _n

Art Unit: 1624

are 0 in formula (I) the substituents R_5 , R_6 and R_7 are not present and therefore, the claims include the reference disclosed compound.

Applicant relied on the proviso statements to overcome the rejection, however, the first proviso statement at page 4, lines 9-10 is not sufficient for the reasons explained above, i.e., when m and n are 0, R_5 , R_6 and R_7 are not present in the structural formula and the requirement that they are other than H has no effect on the compounds of structural formula (I).

7. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Hendrickson et al., Chem. Abstract 110:113878. The instantly claimed compounds read on the reference disclosed compound, see the compound RN 55010-17-8 in the enclosed copy of the CAPLUS computer search report. The reference teaches the presence of the compound in a solvent and therefore, inherently teaches a composition thereof. The proviso statement in claim 1 has been fully considered but not deemed to be sufficient to overcome the rejection because - the proviso recites 'when X is C and R_1 is =O, at least one of R_5 , R_6 and R_7 is other than -H,...', however, when the subscripts m and n are 0 in formula (I) the substituents R_5 , R_6 and R_7 are not present and therefore, the claims include the reference disclosed compound.

Applicant relied on the proviso statements in claim 17 to overcome the above rejection, however, the proviso statement at page 4, lines 11-12 is not sufficient to exclude the reference compound for the reasons stated above.

Art Unit: 1624

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a large, stylized flourish at the end.

Deepak Rao
Primary Examiner
Art Unit 1624

October 6, 2003